

Appl. No. 10/828,539
Reply dated June 19, 2008
Reply to Office Action mailed May 18, 2007

REMARKS

In response to the non-statutory double patenting rejection, Applicant is submitting a terminal disclaimer herewith that overcomes the double patenting rejection and the double patenting rejection should be withdrawn.

PRIOR ART REJECTIONS

In response to the examiner's rejection of claims 1, 3-12, 17-20, 25-26, 29 and 33-42 as being anticipated by US Patent No. 6,585,633 to Vitali et al. ("Vitali"), the rejection of claims 1, 3-23, 25-26 and 29-42 as being obvious over Vitali in view of US Patent Application Publication No. US 2002/0022781 to McIntire et al. ("McIntire") and the rejection of claims 1 and 25-28 as being obvious over Vitali in view of US Patent No. 6,347,443 to Coniglione ("Coniglione"), Applicant respectfully traverses the rejections because: 1) Vitali does not anticipate claims 1, 3-12, 17-20, 25-26, 29 and 33-42 because each element is not found in Vitali for the reasons set forth below; and 2) the combination of Vitali in view of McIntire or Coniglione do not teach or suggest each element of the claims for the reasons set forth below.

Standards

Anticipation Standard

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). *See also MPEP 2131 et seq.*

Obviousness Standard

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference must teach or suggest all the claim limitations. M.P.E.P. § 2143. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must

both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claims 1, 3-12, 17-20, 25-26, 29 and 33-42 – Vitali

Claim 1

The examiner has asserted that this claim is anticipated by Vitali. However, each element of claim 1 is not found expressly or inherently in Vitali and therefore the anticipation rejection is not well-founded and should be withdrawn. In particular, claim 1 recites "a parabolic surface defining a body chamber; and a radioisotopic component inside the body chamber and separated from the parabolic surface in at least one location by a gap" and "the medical device being adapted for implantation into a live body" which are not found expressly or inherently in Vitali.

Vitali discloses a brachytherapy seed cartridge. *See Vitali Title*. For example, Figure 1 shows a seed cartridge assembly that is adapted to hold and dispense radioactive seeds which may be employed to the treatment of, for example, cancerous prostates. *See Vitali at Figure 1 and Col. 4, lines 6-11*. The device in Vitali allows a technician to view the contents of the seed channel. *See Vitali at Figures 31-34 and Col. 8, lines 49-60*.

The claim element "parabolic surface defining a body chamber; and a radioisotopic component inside the body chamber and separated from the parabolic surface in at least one location by a gap" is not found in Vitali. Nothing in Figure 1 of Vitali (cited by the examiner) shows a parabolic surface defining a body chamber and a radioisotopic component inside the body chamber as set forth in the claim. Therefore, this element is not found expressly or inherently in Vitali.

The claim element "the medical device being adapted for implantation into a live body" is not found in Vitali. In particular, while the seeds that are contained in the device of Vitali may be implanted into a live body, clearly the seed cartridge of Vitali cannot be implanted. Therefore, this claim element is not found in Vitali.

Thus, at least two claim elements are not found expressly or inherently in Vitali and the anticipation rejection based on Vitali must be withdrawn.

Claims 3-12, 17-20, 25-26, 29 and 33-42

These claims all depend from claim 1 and the anticipation rejection of these claims must be withdrawn for the same reasons as claim 1.

Claims 1, 3-23, 25-26 and 29-42 - Vitali in view of McIntire

Claim 1

The examiner has asserted that this claim is obvious over Vitali in view of McIntire. However, each element of claim 1 is not taught or suggested by Vitali or McIntire and therefore the examiner has not established a prima facie case of obviousness and the obviousness rejection must be withdrawn. In particular, claim 1 recites “a parabolic surface defining a body chamber; and a radioisotopic component inside the body chamber and separated from the parabolic surface in at least one location by a gap” and “the medical device being adapted for implantation into a live body” which are not taught or suggested by Vitali or McIntire.

Vitali discloses a brachytherapy seed cartridge. *See Vitali Title*. For example, Figure 1 shows a seed cartridge assembly that is adapted to hold and dispense radioactive seeds which may be employed to the treatment of, for example, cancerous prostates. *See Vitali at Figure 1 and Col. 4, lines 6-11*. The device in Vitali allows a technician to view the contents of the seed channel. *See Vitali at Figures 31-34 and Col. 8, lines 49-60*.

The claim element “parabolic surface defining a body chamber; and a radioisotopic component inside the body chamber and separated from the parabolic surface in at least one location by a gap” is not taught or suggested by Vitali or McIntire. For Vitali, nothing in Figure 1 of Vitali (cited by the examiner) shows a parabolic surface defining a body chamber and a radioisotopic component inside the body chamber as set forth in the claim. For McIntire, nothing teaches or suggests this element as admitted by the examiner.

In addition, the claim element “the medical device being adapted for implantation into a live body” is not taught or suggested by Vitali or McIntire. For Vitali, while the seeds that are contained in the device of Vitali may be implanted into a live body, clearly the seed cartridge of Vitali cannot be implanted. For McIntire, nothing teaches or suggests this element as admitted by the examiner.

Thus, at least these two claim elements are not taught or suggested by Vitali or McIntire and therefore the examiner has not established a prima facie case of obviousness and the rejection must be withdrawn.

Claims 3-23, 25-26 and 29-42

These claims all depend from claim 1 and the obviousness rejection of these claims must be withdrawn for the same reasons as claim 1.

Claims 1 and 25-28 - Vitali in view of Coniglione

Claim 1

The examiner has asserted that this claim is obvious over Vitali in view of Coniglione. However, each element of claim 1 is not taught or suggested by Vitali or Coniglione and therefore the examiner has not established a *prima facie* case of obviousness and the obviousness rejection must be withdrawn. In particular, claim 1 recites “a parabolic surface defining a body chamber; and a radioisotopic component inside the body chamber and separated from the parabolic surface in at least one location by a gap” and “the medical device being adapted for implantation into a live body” which are not taught or suggested by Vitali or Coniglione.

Vitali discloses a brachytherapy seed cartridge. *See Vitali Title*. For example, Figure 1 shows a seed cartridge assembly that is adapted to hold and dispense radioactive seeds which may be employed to the treatment of, for example, cancerous prostates. *See Vitali at Figure 1 and Col. 4, lines 6-11*. The device in Vitali allows a technician to view the contents of the seed channel. *See Vitali at Figures 31-34 and Col. 8, lines 49-60*.

The claim element “parabolic surface defining a body chamber; and a radioisotopic component inside the body chamber and separated from the parabolic surface in at least one location by a gap” is not taught or suggested by Vitali or Coniglione. For Vitali, nothing in Figure 1 of Vitali (cited by the examiner) shows a parabolic surface defining a body chamber and a radioisotropic component inside the body chamber as set forth in the claim. For Coniglione, nothing teaches or suggests this element as admitted by the examiner.

In addition, the claim element “the medical device being adapted for implantation into a live body” is not taught or suggested by Vitali or Coniglione. For Vitali, while the seeds that are contained in the device of Vitali may be implanted into a live body, clearly the seed cartridge of Vitali cannot be implanted. For Coniglione, nothing teaches or suggests this element as admitted by the examiner.

Thus, at least these two claim elements are not taught or suggested by Vitali or Coniglione and therefore the examiner has not established a *prima facie* case of obviousness and the rejection must be withdrawn.

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Claims 25-28

These claims all depend from claim 1 and the obviousness rejection of these claims must be withdrawn for the same reasons as claim 1.

CONCLUSION

In view of the above, it is respectfully submitted that Claims 1, 3-23, 25-42 and 45 are allowable over the prior art cited by the Examiner and early allowance of these claims and the application is respectfully requested.

The Examiner is invited to call Applicant's attorney at the number below in order to speed the prosecution of this application.

The Commissioner is authorized to charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 07-1896.

Respectfully submitted,

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Dated: June 19, 2008

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